

REMARKS

Allowance of the present application is respectfully requested on the basis of the following reasons.

1. Rejection of claim 20 under 35 U.S.C. 112, second paragraph

W/D
Claim 20 has been amended to overcome this rejection by reciting that the composition of the surface coating includes "acrylates or a mixture of acrylate and non-acrylate polymers or copolymers having a greater acrylate content in comparison to non-acrylate polymers in said composition." In view of the amendment, Applicants submit that amended claim 20 is sufficiently definite in that it is ascertainable as to what the acrylate content is compared to. Accordingly, claim 20 complies with 35 U.S.C. 112, second paragraph and withdrawal of this rejection is requested.

2. New Claims

Applicants provide herewith new claims 38-45 that recite that the dirt repellant surface coating coats fibers of the security paper. Applicants submit that the cited prior art references fail to disclose the subject matter recited in new claims 38-45. Accordingly, new claims 38-46 are in condition for allowance.

3. Rejection of claims 18, 24, 28 and 35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,161,829 (Detrick et al.)

This rejection is respectfully traversed on the grounds that Detrick et al. '829 fails to disclose or suggest a surface coating for a security paper that is [dirt repellant], as recited in amended claim 18. Accordingly, claim 18 is patentable. Claims 24, 28, 35, which depend directly from claim 18, are at least patentable in view of their dependency from claim 18 and their individually recited features.

More specifically, Detrick et al. '829, discloses a security paper with two layers and an adhesive layer that permanently adheres the two layers together. In the

Office Action, it is noted that the "adhesive layer" lacks polyurethane and a filler substance. While this apparently seems to be true, the adhesive layer in Detrick et al. '829 **cannot** reasonably be construed to disclose a surface coating that is "dirt repellant." This is due to the simple fact that an adhesive cannot function as an adhesive and as a dirt repellant, since each property is an exact opposite of one another.

In view of the above observation, Applicants submit that Detrick et al. '829 fails to disclose or suggest the security paper of the present invention having a surface coating that is dirt repellant.

4. Rejection of claims 18-19, 21-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,161,829 (Detrick et al.) in view of U.S. Patent 5,601,683 (Martin)

This rejection is traversed on the grounds that Detrick et al. '829 and Martin '683, whether considered individually or collectively, fail to disclose or suggest the security paper recited in claim 18 having a dirt repellant surface coating. Accordingly, claim 18 is patentable. Claims 19, 21-28 and 35 are therefore at least patentable in view of their dependency from claim 18 and their individually recited features.

For the reasons discussed above in reference to the rejection based on anticipation, Applicants submit that Detrick et al. '829 fails to disclose or suggest the security paper recited in claim 18 of the present application. Turning to Martin '683, this reference equally fails to disclose or suggest the security paper having the dirt repellant surface coating.

Martin '683 generally relates to a photocopy resistant document that includes a substrate which is a matte onto which indicia are printed, the indicia being a coating mixture including a dye means in a resin-based carrier means. Despite its teachings, Martin '683 fails to provide any suggestion of the desirability or a

motivation for applying a dirt repellant surface coating on a security paper as recited in claim 18 of the present invention.

As a result of the above-observations, it is respectfully submitted that no reasonable combination of the security paper of Detrick et al. '829 or the photocopy resistant document of Martin '683 could have suggested the claimed invention of claim 18 to someone of ordinary skill in the art. Accordingly, withdrawal of the rejection is respectfully requested.

5. Rejection of claims 29-34 and 36-37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,817,205 (Kaule)

This rejection is traversed on the grounds that Kaule '205 fails to disclose or suggest the methods recited in claims 29 and 30 of the present invention. More specifically, Kaule '205 does not teach a document of value having a dirt repellant surface coating as recited in claim 29 of the present invention and further does not teach the method of producing a security paper that includes the step of applying a dirt repellant coating to the paper.

Kaule '205 describes a method for making a data carrier that includes a surface portion corresponding to an optically variable element that is smoother than the remaining surface of the data carrier. It will be noted, however, that Kaule '205 does not contain a description or suggestion concerning the application of a dirt repellant surface coating to the data carrier described therein.

Accordingly, since Kaule '205 fails to disclose or suggest the dirt repellant surface coating and the application thereof onto a security paper, Applicants submit that Kaule '205 fails to anticipate the present invention recited in claims 29-34 and 36-37. Therefore, withdrawal of the rejection is respectfully requested.

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Examiner: Lawrence D. FERGUSON
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6. Conclusion

In view of the new claims, the amendments to the pending claims , and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 18-45 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicants' Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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